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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,542	08/03/2000	Ryoichi Imanaka	MAT-3720US3	9883
7590 08/17/2009				
Ratner & Prestia P O Box 980 Valley Forge, PA 19482			EXAMINER PARRY, CHRISTOPHER L	
			ART UNIT 2421	PAPER NUMBER
			MAIL DATE 08/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/631,542

**Applicant(s)**

IMANAKA, RYOICHI

**Examiner**

CHRIS PARRY

**Art Unit**

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 17 and 18 have been considered but are moot in view of the new ground(s) of rejection.

### ***Oath/Declaration***

2. The reissue oath/declaration filed 19 March 2002 with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue declaration fails to specifically identify at least one error, as just merely listing a claim as an error is insufficient. In addition, it is not sufficient to merely reproduce the claims with brackets and underlining and state that such will identify the error. See *In re Constant*, 827 F.2d 728, 729, 3 USPQ2d 1479 (Fed. Cir.), cert. denied, 484 U.S. 894 (1987). Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. See MPEP § 1414 II(C).

### ***Claim Rejections - 35 USC § 251***

3. Claims 17-18 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

#### ***Specification***

4. The disclosure is objected to because of the following informalities: The specification must be amended to include a cross reference to all co-pending reissue applications at line 1 of the first page of the specification to patent number 5,790,172.

Appropriate correction is required.

#### ***Claim Objections***

5. Claims 17 and 18 are objected to because of the following informalities: Any changes relative to the patent being reissued which are made to the specification, including the claims, upon filing, or by an amendment paper in the reissue application, must include the following markings: The matter to be omitted by reissue must be enclosed in brackets. Thus, all claims of the original patent should appear in the reissue patent, with canceled patent claims being enclosed in heavy brackets. See 37 CFR 1.173(d). Appropriate correction is required.

6. Claim 18 is objected to because of the following informalities: On line 1 of Claim 18, "A subscriber apparatus" should be --A server apparatus--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 17 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Durden et al. "Durden" (USPN 5,003,384) in view of Lett et al. "Lett" (USPN 5,592,551).

Regarding Claim 17, Durden discloses a server apparatus (5-10, 18 and 19 – fig.

1) comprising:

an information provider (18 – fig. 1) which receives an information (i.e., "Pre-Buy" request or "Buy" request) from a subscriber apparatus (15 – fig. 1), the information showing whether output signal outputted from said server apparatus is provided to a display terminal or a recorder in said subscriber apparatus (i.e., memory 21 is used to store the purchase history of the user, specifically stores whether the purchase was a "Pre-Buy" which allows the user to record the program or a "Buy" which allows the user to view the program immediately on the display terminal) (figs. 1 & 3; Col. 6, lines 43-66 and Col. 12, lines 7-35);

a subscriber mode recognizer (8 – fig. 1) which discriminates whether said output signal is provided to the display terminal or the recorder based on the information (i.e., set-top terminal 15 provides event records to system manager 8, where system manager 8 determines whether the request is a "Pre-Buy" or a "Buy" in order to

determine whether to charge the user now or later) (Col. 6, line 43 to Col. 7, line 4 and Col. 12, lines 24-63); and a charger (5 – fig. 1) (Col. 4, lines 45-65).

Durden fails to specifically disclose a charger which charges a different amount among a) in the case that the output signal is provided to said display terminal and b) in the case that said output signal is provided to said recorder, based on the recognition of said subscriber mode recognizer.

In an analogous art, Lett discloses a charger (i.e., system manager 22 controls billing for PPV and NVOD events) which charges a different amount among a) in the case that the output signal is provided to said display terminal (20 – fig. 2) (i.e., the user may watch a “free” preview of a PPV event) and b) in the case that said output signal is provided to said recorder (18 – fig. 2), based on the recognition of said subscriber mode recognizer (i.e., user must purchase the event and is charged a fee in order to record the program) (Col. 14, lines 38-67 and Col. 4, lines 41-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Durden to include a charger which charges a different amount among a) in the case that the output signal is provided to said display terminal and b) in the case that said output signal is provided to said recorder, based on the recognition of said subscriber mode recognizer as taught by Lett for the benefit of providing a video-on-demand system to subscribers that is user-friendly and easy to use (Lett: Col. 2, lines 60-61).

As for Claim 18, Durden and Lett disclose a subscriber apparatus according to claim 17, in particular Lett teaches wherein said charger [22] charges a larger amount when the output signal is provided to said recorder [18] than to said display terminal [20] (i.e., the user may watch a "free" preview of a PPV event on the display or must purchase the event and is charged a fee in order to record the program, thus system manager 22 charges a larger amount when the output signal is provided to VCR 18) (Col. 14, lines 38-67 and Col. 4, lines 41-67).

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS PARRY whose telephone number is (571) 272-8328. The examiner can normally be reached on Monday through Friday, 8:00 AM EST to 4:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN MILLER can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/  
Supervisory Patent Examiner, Art Unit 2421

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